REMARKS

Claims 10, 12-14, 16-19, 22-24, 26-48 and 50-53 are pending, and claims 1-9, 11, 15, 20-21, 25 and 49 have been canceled.

Claims 10, 14, 18 and 50-53 were rejected under 35 U.S.C. §112 as being indefinite.

As noted in the previous response, there is nothing wrong with defining the dimensions of a device in terms of the environment in which it is to be used. See *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575-76, 1 USPQ2d 1081, 1087-88 (Fed. Cir. 1986) (holding that the limitation that the claimed wheelchair have a "front leg portion ... so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof" was not indefinite). Furthermore, axle sizes are standardized. A copy of Japanese Industrial Standards (JIS) D 9419 showing the standardized axle sizes is attached to the end of this response. As shown in the attached figures, the axle sizes are 5/16" or 3/8" for most hubs, or 9 or 10 mm for quick release hubs. Clearly, there is not an indefinite number of possible sizes for axles, so this basis for rejection is respectfully traversed.

Claims 10, 14, 18 and 51-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Swensen (US 3,184,993). This basis for rejection is respectfully traversed.

The office action states that it would be obvious to modify the dimensions of opening (6a) in the Swensen device to receive an axle therein. However, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 10 USPQ2d 1397 (Fed.Cir. 1989). In other words, there must be a reason why one of ordinary skill in the art would be motivated to enlarge opening (6a) in the Swensen derailleur to receive an axle therethrough, given that opening (6a) is an opening used to attach the derailleur guard to a pin (a2) of derailleur (a) and the derailleur guard already has an axle opening (6a). Furthermore, the motivation to combine must be clear and particular, and it must be supported by actual evidence. *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ.2d 1374, 1387 (Fed.Cir. 2002). The office action states at page 3 that (1) one would have been

motivated to ensure proper sizing of the opening relative to an axle or rod received therein; and (2) it has been held that a change in the size of a prior art device is a design consideration within the skill in the art. However, (1) is circular reasoning (i.e., one would be motivated to make the modification in order to make the modification), and (2) is an example of a "negative rule of invention" devoid of any case cite or comparison between the facts of this case and the non-cited case. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ.2d 1127, 1133 (Fed.Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." See also *Ex parte Granneman*, 68 USPQ.2d 1219, 1220 (Bd.Pat.App& Inter. 2003).

The statement bridging pages 4 and 5 of the office action is ambiguous. The Federal Circuit in *Orthokinetics* did *not* hold that "where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed and relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device." If the examiner is referring to another case with that holding, then that case should be cited and the facts of that case and the presently claimed invention compared. In any event, the presently claimed device performs differently from the Swensen device because of the axle mounting of the presently claimed device, which the Swensen device is incapable of doing. The applicant submits that there is no evidence of a motivation to enlarge Swensen's opening (6a) to receive an axle therethrough.

Accordingly, it is believed that the rejections under 35 U.S.C. §103 and §112 have been overcome by the foregoing remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application is respectfully requested. Allowance of all claims is earnestly solicited.

Respectfully submitted,

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Reg. No. 31,242

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JIS

CYCLES

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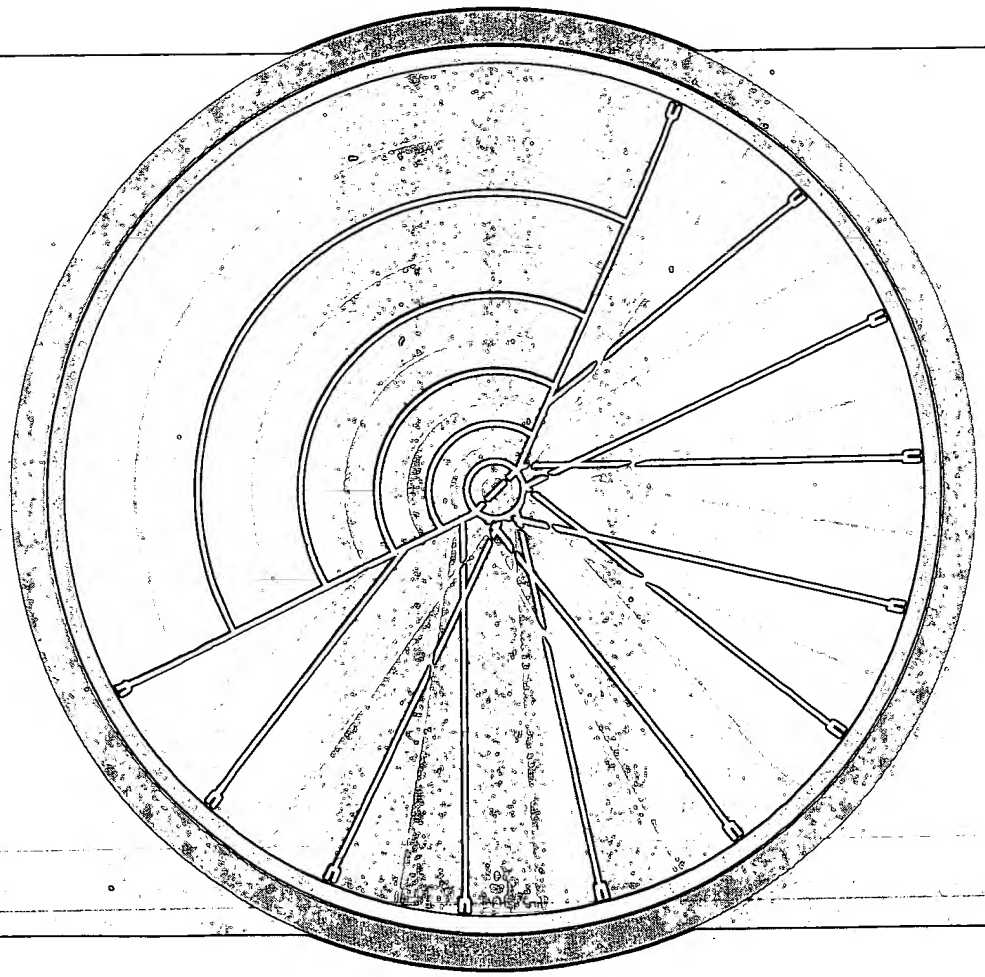
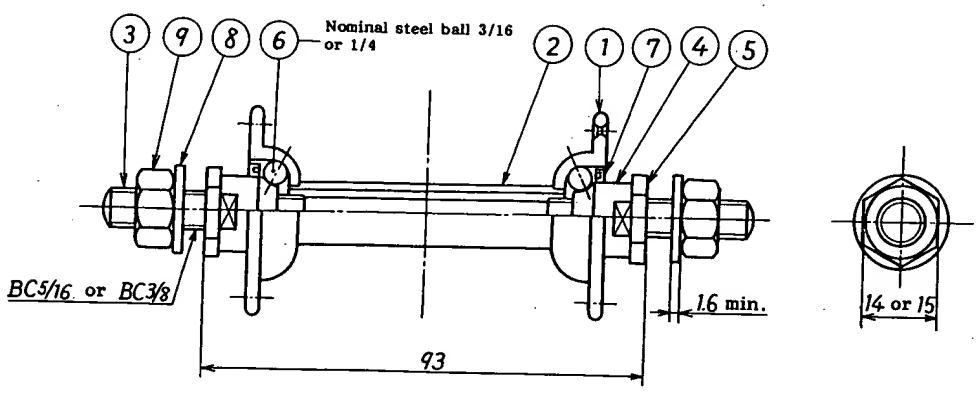


JAPAN BICYCLE PROMOTION INSTITUTE

Attached Fig. 1. Ordinary Hubs

(1) Ordinary Front Hub

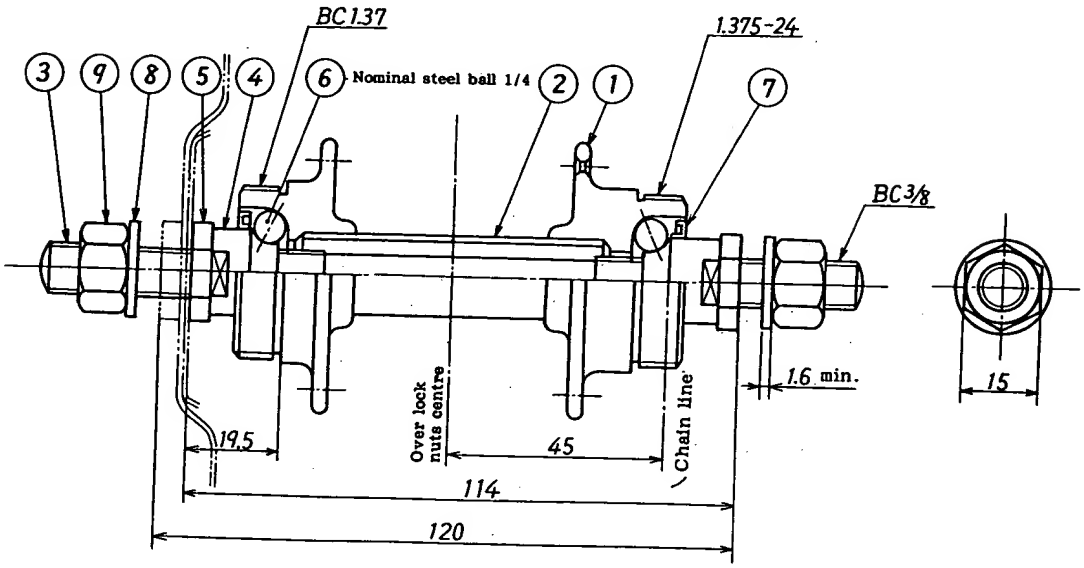
Unit: mm



(2) Ordinary Rear Hub

(a) For with Brake Drum

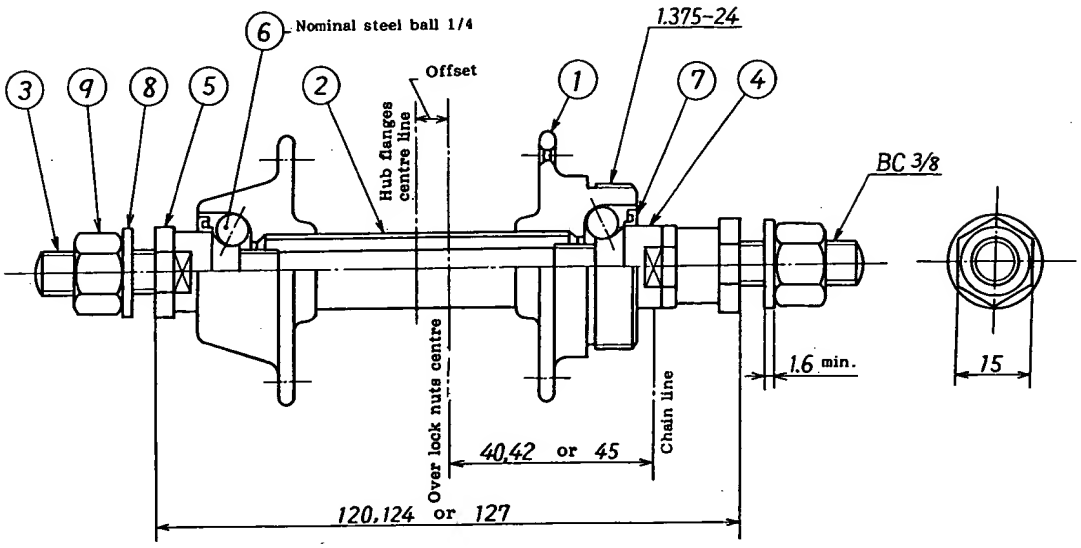
Unit: mm



Attached Fig. 1 (Continued)

(b) For Multiple Free Wheel

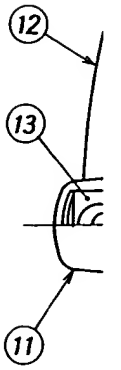
Unit: mm



No.	Name of part		Material (Informative reference)
1	Hub shell	Hub flange	SPCC or SPCD of JIS G 3141 S 17 C or S 15 C of JIS B 4051
2		Pipe	STKM 11 A of JIS G 3445
3	Hub axle		SS 41 of JIS G 3101
4	Hub cone		S 15 C of JIS G 4051
5	Lock nut		SS 41 of JIS G 3101 S 15 C K of JIS G 4051
6	Steel ball		JIS B 1501, JIS D 9404
7	Water-preventive cap		SPCC of JIS G 3141
8	Washer		SS 41 of JIS G 3101
9	Hub nut		SS 41 of JIS G 3101

(1) Front

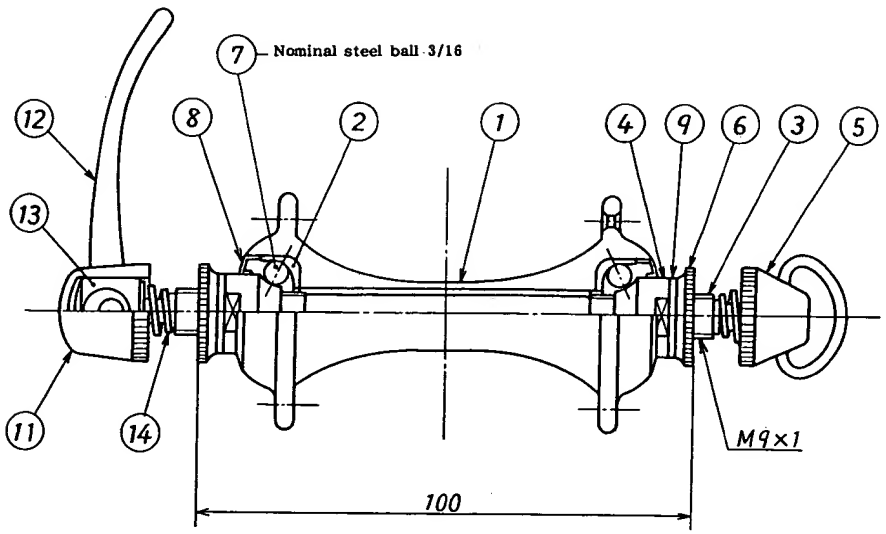
(2) Rear



Attached Fig. 2. Quick Release Hubs

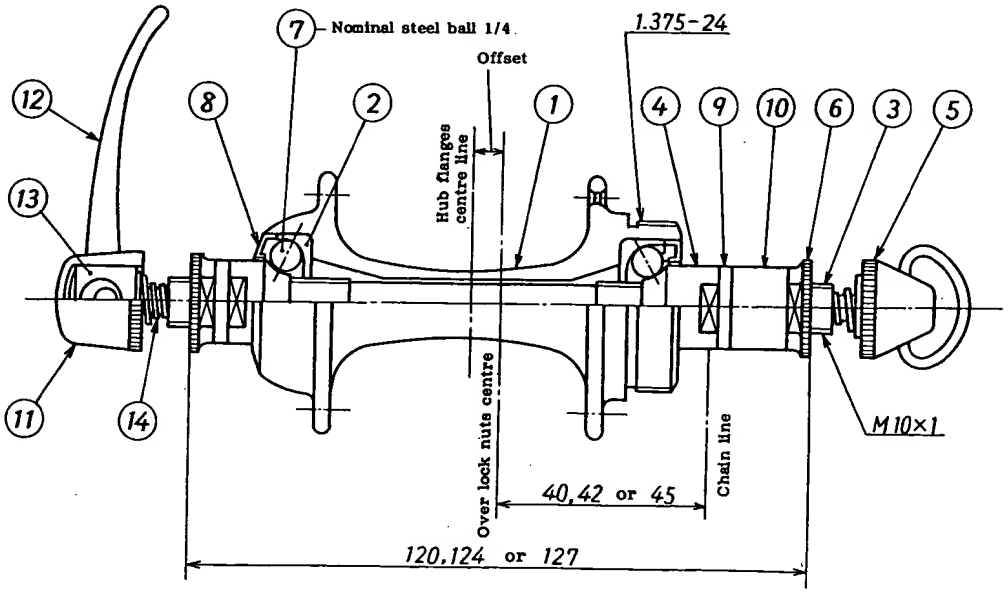
(1) Front Quick Release Hub

Unit: mm



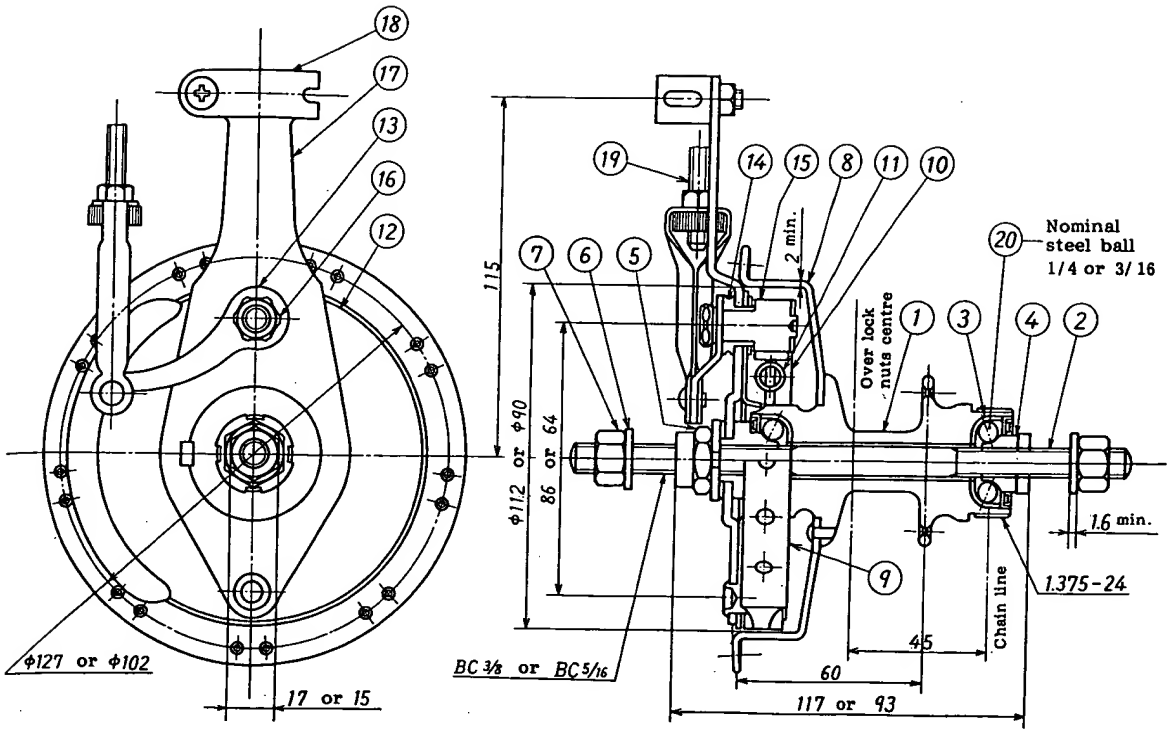
(2) Rear Quick Release Hub

Unit: mm



Attached Fig. 3. Hub Brake

Unit: mm

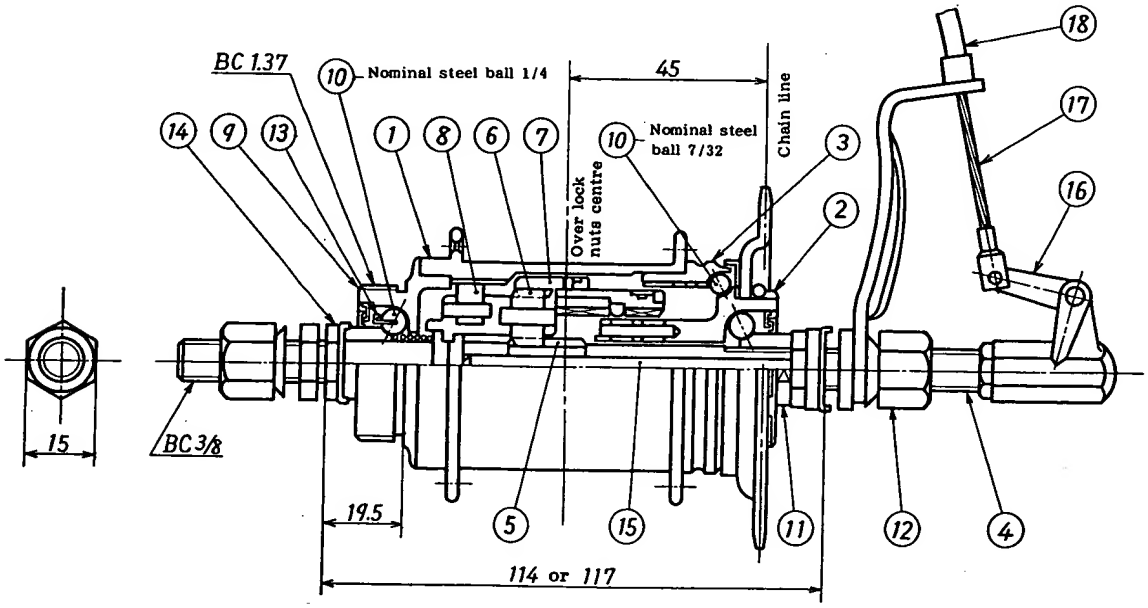


No.	Name of part	Material (Informative reference)	No.	Name of part	Material (Informative reference)
1	Hub shell	SPCC of JIS G 3141	11	Return spring	SWB of JIS G 3521
2	Hub axle	SGD 2 of JIS G 3108	12	Hub brake cover	SPCC of JIS G 3141
3	Hub cup	SPHD of JIS G 3131	13	Bell crank	SPHC of JIS G 3131
4	Hub cone	SS 41 of JIS G 3101	14	Bush	SS 41 of JIS G 3101
5	Lock nut	SWRM of JIS G 3505	15	Cam	SUM of JIS G 4804
6	Washer	SPHD of JIS G 3131	16	Bell crank nut	SWRM of JIS G 3505
7	Hub nut	SWRM OF JIS G 3505	17	Brake arm	SPHD of JIS G 3131
8	Hub brake drum	SPHD of JIS G 3131	18	Attaching clip	SPCC of JIS G 3141
9	Hub brake lining	Synthetic rubber	19	Control rod	SS 41 of JIS G 3101
10	Hub brake shoe	SPCC of JIS G 3141	20	Steel ball	JIS B 1501, JIS D 9404

Attached Fig. 4. Hub Gear

(a) Main Body

Unit: mm

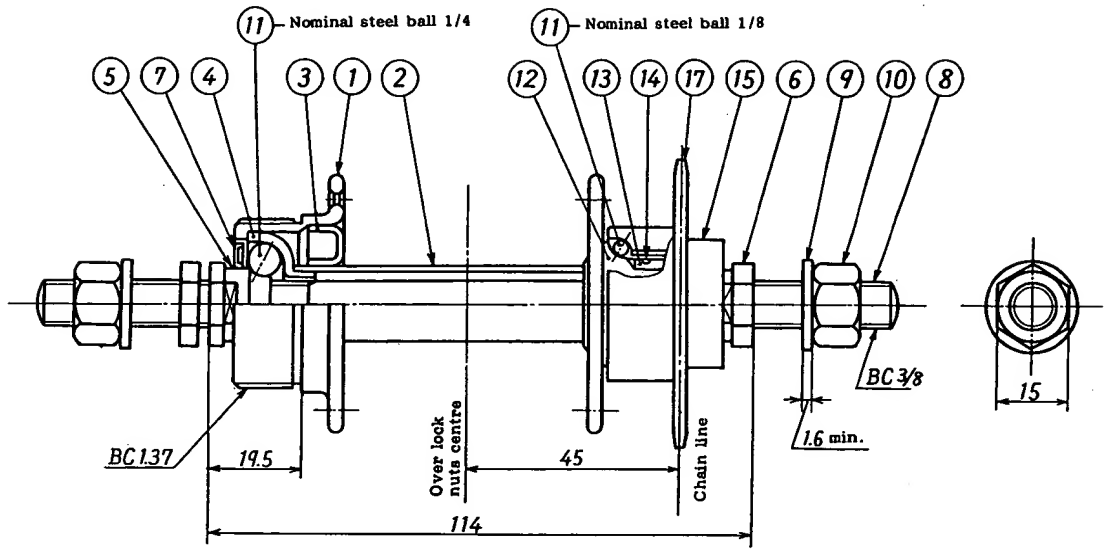


No.	Name of part		Material (Informative refernece)
1	Hub shell		SPCC of JIS G 3141
2	Driver		S 20 C of JIS G 4051
3	Right hub cup		STKM 13 A of JIS G 3445
4	Hub gear axle		SCM 415 of JIS G 4105
5	Sun pinion		SCM 415 of JIS G 4105
6	Planet pinion		SCM 415 of JIS G 4105
7	Gear ring		S 17 C of JIS G 4051
8	Pawl		SCM 415 of JIS G 4105
9	Left hub cup		S 15 C of JIS G 4051
10	Steel ball		JIS B 1501, JIS D 9404
11	Hub cone		SCM 415 of JIS G 4105
12	Hub nut		SS 41 of JIS G 3101
13	Ball retainer		SPCC of JIS G 3141
14	Lock nut		SS 41 of JIS G 3101
15	Push rod		SWRH 42 A of JIS G 3506
16	Bell crank		ZDC 1 of JIS H 5301
17	Wire	Inner	SWRH 62 A of JIS G 3506
18		Outer	SWRH 62 A of JIS G 3506 SWO-A of JIS G 3560

Attached Fig. 5. Unit Hub

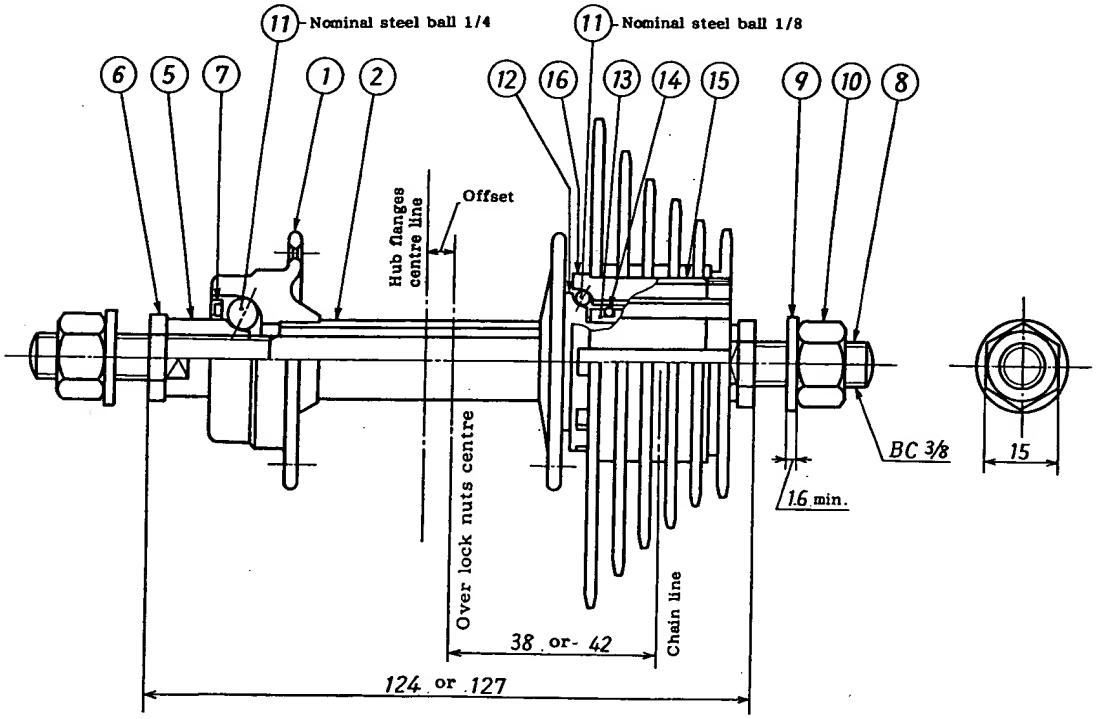
(1) With Combined Hub Cog

Unit: mm



(2) For Multistepped Hub Cog

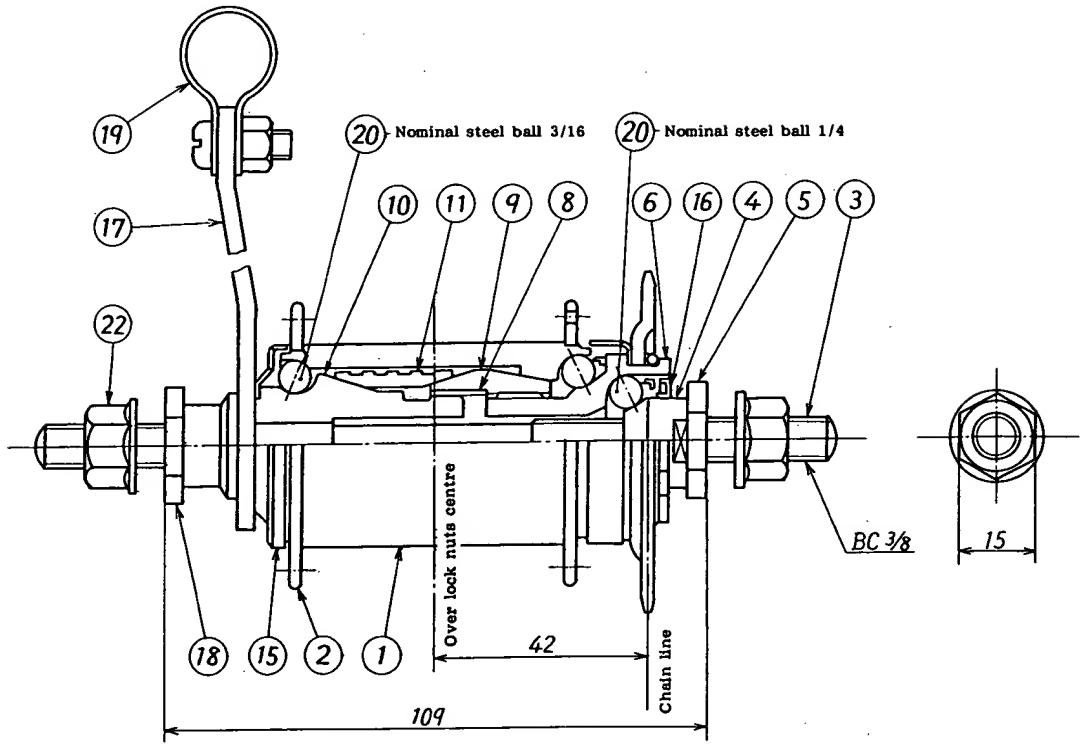
Unit: mm



Attached Fig. 6. Coaster Hub

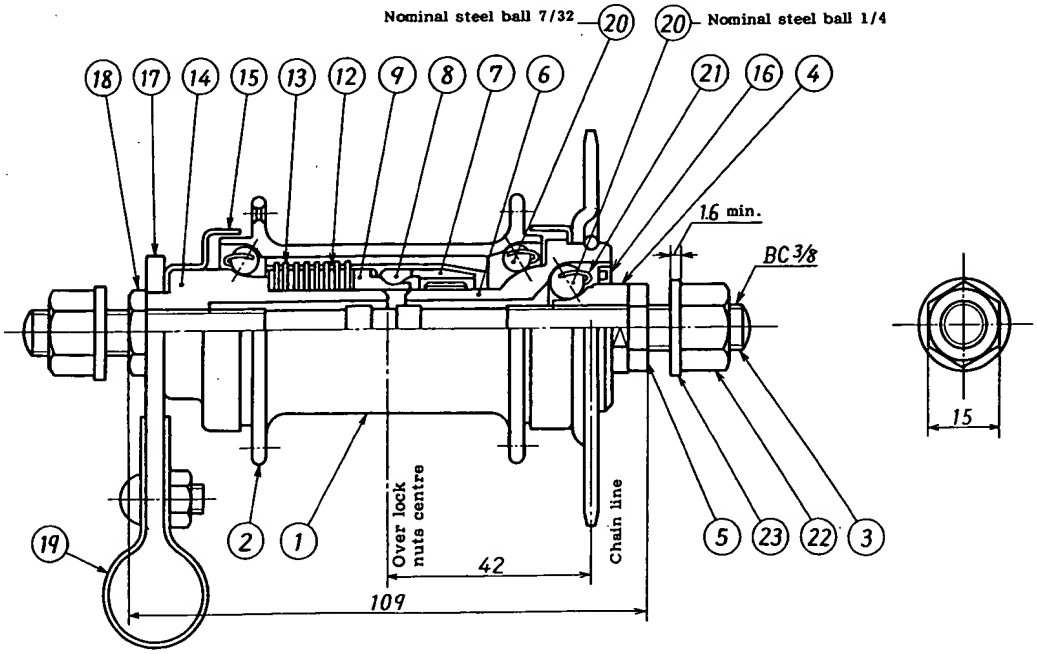
(1) Shoe Type

Unit: mm



(2) Disc Type

Unit: mm



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